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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,428	07/09/2001	Craig M. Whitehouse	840.052203	8546

7590 11/29/2005
Levisohn, Lerner, Berger & Langsam
Suite 2400
757 Third Avenue
New York, NY 10017

EXAMINER

NGUYEN, KIET TUAN

ART UNIT PAPER NUMBER

2881

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/901,428	WHITEHOUSE ET AL.	
	Examiner	Art Unit	
	Kiet T. Nguyen	2881	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 99 and 115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 99 and 115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This application having SN: 09/901,428, filed on 09 July 2001 being after the date 14 March 2001 of six months from the date 14 September 2000 of mailed out the first office action of the prior application SN: 09/448,857 which is abandoned, is lacking copendency between the current application and the prior applications having SN: 09/448,857 which is abandoned, SN: 08/971,521 patented No. 6,020,586, SN: 08/689,459 patented No. 5,689,111 and SN: 08/694,542 patented No. 6,011,259, as required.

Therefore, this application having SN: 09/901,428 has not the condition for receiving the benefit of an earlier filing date under 35 U.S.C. 120. Claims 99 and 115 in this application having SN: 09/901,428 have been not considered to be an interference with US Patent No. 6,285,027.

Since the applications are not copending, the benefit claim to the prior-filed application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

The final rejection in the office action, mailed on 17 August 2004, is now withdrawn for the reasons above and applying the rejection under 35 U.S.C. 102(e) to claims 99 and 115. However, the objected drawing(s) and the rejection under 35 U.S.C. 112, first paragraph are still maintained for reasons above.

Objected Drawings

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The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, **the first mass resolving spectrometer for selecting parent ions having a first desired mass to charge ratio from an ion stream; the means for subjecting the selected parent ions having a first desired mass to charge ratio to collision induced dissociation to generate fragment ions; means for trapping the fragment ions and any remaining parent ions; means for periodically releasing pulses of the trapped ions into a Time-Of-Flight instrument to detect ions with a second mass to charge ratio; and means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio** as recited in claims 99 and 115 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

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the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Rejection Under 35 U.S.C. 112, First Paragraph

Claims 99 and 115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is unclear for reciting the limitations **“the first mass resolving spectrometer for selecting parent ions having a first desired mass to charge ratio from an ion stream”**; **“the means for subjecting the selected parent ions having a first desired mass to charge ratio to collision induced dissociation to generate fragment ions”**; **“means for trapping the fragment ions and any remaining parent ions”**; **“means for periodically releasing pulses of the trapped ions into a Time-Of-Flight instrument to detect ions with a second mass to charge ratio”**; and **“means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio”** as recited in claims 99 and 115.

Therefore, the Examiner don't understand what is the device that is used to select parent ions having a first desired mass to charge ratio from an ion stream? What is the device that is used to subject the selected parent ions having a first desired mass to charge ratio to collision induced dissociation to generate fragment ions? What is the

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device that is used to trap the fragment ions and any remaining parent ions? What is the device that is used to periodically release pulses of the trapped ions into a Time-Of-Flight instrument to detect ions with a second mass to charge ratio? And what is the device that is used to adjust the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio ?

Additional explanations are needed if applicant insists on including these features in claims 99 and 115 without the introduction of new matter.

Rejection Under 35 U.S.C. 102(e)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 99 and 115 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chernushevich et al. (6,285,027) for the reasons above. See claim 1 of patent No. 6,285,027.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet T. Nguyen whose telephone number is 571-272-2479. The examiner can normally be reached on Monday-Friday from 8.00 AM to 6.00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee, can be reached on Monday-Friday. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KIET T. NGUYEN
PATENT EXAMINER